



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/817,878	03/26/2001	L. Lloyd Williams	SWA01 P-104	7630

28101 7590 01/10/2005

VAN DYKE, GARDNER, LINN AND BURKHART, LLP
2851 CHARLEVOIX DRIVE, S.E.
P.O. BOX 888695
GRAND RAPIDS, MI 49588-8695

EXAMINER

HEWITT II, CALVIN L

ART UNIT	PAPER NUMBER
----------	--------------

3621

DATE MAILED: 01/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

P12

Office Action Summary	Application No. 09/817,878	Applicant(s) WILLIAMS ET AL.	
	Examiner Calvin L Hewitt II	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-16,18-22 and 25-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-16,18-22 and 25-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10-7-04</u> . | 6) <input type="checkbox"/> Other: _____ |

Status of Claims

1. Claims 1-3, 5-16, 18-22, and 25-36 have been examined.

Response to Arguments

2. Applicant's arguments with respect to claims 1-36 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-5, 9, 15, 16, 20, 28, 32, and 33 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Cohen, U.S. Patent No. 6,422,462.

As per claims 1-5, 9, 15, 16, 20, 28, 32, and 33, Cohen teaches a method for distributing content comprising:

- receiving a request message for the content over a network (column 5, lines 27-33)
- formulating a transaction indicia uniquely associated with said message (column 2, lines 35-41; column 3, lines 49-55; column 5, lines 29-35) and conveying the indicia to the party through a voice connection (column 3, lines 40-48).
- receiving a validation message returned by the party containing the indicia (column 5, lines 44-49)
- an indicia valid for only one request (column 3, lines 49-55)
- indicia with a limited time to live and content is not delivered unless the validation message is received before the time to live is expired (column 5, lines 44-49)
- formulating a transaction indicia comprising authenticating a right of the party to receive content (column 3, lines 49-55)
- automatically returning the transaction indicia through the communication network using customer premise equipment (column 5, lines 35-41)
- authenticating a right of the party to receive the content by determining whether the party is located within a predetermined domain using the information identifying the party (column 5, lines 35-48)

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 6-8, 10, 11, 18, 19, 29-31, and 34-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen, U.S. Patent No. 6,422,462 in view of Sussman, U.S. Patent No. 6,836,765.

As per claims 6-8, 29-31, and 34-36, Cohen teaches authenticating a party to determine a party's right to obtain content (column 5, lines 43-48). Cohen also teaches obtaining the indicia over a phone network (column 3, lines 19-27) and automatically returning the transaction indicia via the internet using customer premise equipment (column 5, lines 35-41). However, Cohen doesn't explicitly recite authenticating a user by telephone number. Sussman teaches a method for authenticating a transaction indicia that comprises querying a database in order to authenticate a party using a telephone number to determine whether the party is located within a pre-determined domain (e.g. geographical region, service area, company employee or internet domain) (column 21, lines 1-42; column 31, lines 10-41). Therefore, it would have been obvious to combine the teachings of Cohen and Sussman in order prevent or limit the use of stolen multi-

use card numbers ('765, column 17, lines 17-45; '462, column 3, lines 55-67, column 12, lines 3-8)

As per claims 10, 11, 18, 19, Cohen teaches establishing a voice connection with a party (column 3, lines 18-27 and 40-55; column 5, lines 28-35). However, Cohen does not specifically recite determining the address of the party. Sussman teaches a method for authenticating a transaction indicia that comprises obtaining party specific data such as an address, e-mail, phone number or other confidential information that can be used to challenge a party in the event of a questionable transaction (column 17, lines 17-45; column/line 19/1-21/41). Therefore, it would have been obvious to combine the teachings of Cohen and Sussman in order prevent or limit the use of stolen multi-use card numbers ('765, column 17, lines 17-45; '462, column 3, lines 55-67, column 12, lines 3-8).

7. Claims 12, 22, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen, U.S. Patent No. 6,422,462.

As per claims 12, 22, and 25, Cohen teaches establishing a voice connection with a party (column 3, lines 18-27 and 40-55; column 5, lines 28-35). For example, Cohen teaches a party contacting an indicia-issuer to confirm the use of a transaction indicia (column 7, lines 5-10). Cohen does not specifically recite the use of IVR. However, programmable IVR units are old and well-known

and therefore it would have been obvious to one of ordinary skill to implement an IVR system at the indicia-issuer end to perform remedial tasks, thus allowing live operators to spend time on more complicated matters.

8. Claims 13, 14, 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen, U.S. Patent No. 6,422,462, in view of Billings, U.S. Patent No. 5,737,422 and Cane et al., U.S. Patent No. 5,416,840.

As per claims 13, 14, 26 and 27, Cohen teaches a method for securely obtaining content over a network (column 3, lines 34-39). However, Cohen does not specifically recite encrypting the content. Billings teaches a method for securely distributing content to a user by requiring the user to transmit an id to a remote computer, encrypting data using a key based on said id and transmitting the encrypted data to a user (column 6, lines 58-67; column 7, lines 35-60). While Cane teaches a remote computer generating an encryption key based on an id, such as a hardware identifier transmitted to a remote computer from a user (abstract; column 2, lines 32-65; column 6, lines 3-45). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Cohen, Billings and Cane et al. in order to further secure the system by protecting the content from malicious parties ('840, figure 3).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Walker et al. teach a method and system for creating and distributing single use transaction indicia

10. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (703) 308-8057. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (703) 305-9768.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
c/o Technology Center 2100
Washington, D.C. 20231

or faxed to:

(703) 305-7687 (for formal communications intended for entry and after-final communications),

or:

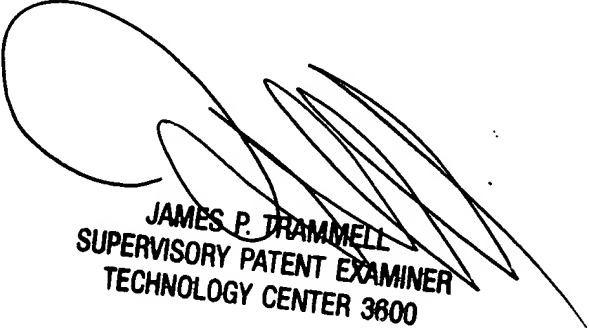
(703) 746-5532 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 5,
2451 Crystal Drive, 7th Floor Receptionist.

Any inquiry of a general nature or relating to the status of this application
should be directed to the Group receptionist whose telephone number is (703)
308-1113.

Calvin Loyd Hewitt II

January 5, 2005



JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3800